

Remarks

As discussed in detail below, Applicant respectfully submits that the Office Action's §112 and §103 rejections are erroneous and contradict claim-construction tenets set forth in the MPEP. The §112 rejections rely on the erroneous suggestion that word-for-word support is required for claim terms and present arguments that are unsupported by the record. The §103 rejections attempt to show correspondence to the prior art by construing claim terms in a manner that contradicts both the evidence of record and definitions accepted throughout the banking industry, and in many instances ignores claim terms and thereby fails to consider each claim as a whole. Moreover, the §103 rejections attempt to show that the skilled artisan would be motivated to combine teachings without evidence for the combination and in an illogical manner that would result in a system that is entirely different than the one intended by the primary reference. With respect to each of these issues, Applicant respectfully submits that the evidence of record is unambiguous.

The Office Action dated January 16, 2007 listed the following rejections: claims 45-66 under § 112(1) regarding the three terms (i) "consideration-bearing bank account", (ii) "providing a time window for users to provide funds for the transaction card purchases", and (iii) "a communication protocol implemented with the user during the transaction"; and claims 45, 48, 51-53, 55-56, 59, 62-64 and 66 under § 112(2) for the second of the above-listed terms; and claims 45-66 under 35 U.S.C. §103(a) over Bissonette *et al.* (the '279 reference) in view of Fleischl (the '552 reference). Applicant respectfully traverses each of these rejections.

For the rejections addressing each of these terms, Applicant submits that the § 112(1) applies an erroneous standard and that the specification satisfies all aspects of § 112. The Office Action (Response to Arguments) erroneously alleges that the specification does not use "the specific words" and does not set forth "the exact metes and bounds", and "nowhere does the specification set forth exactly what constitutes a 'consideration bearing bank account'". The law, however, merely requires that the specification "reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application [and], the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." *See* MPEP 2163. This portion of the MPEP goes on to explain that lack of word-for-word ("*ipsis verbis*") correspondence between the claim terms and the specification is not a proper basis for a rejection under §112(1); thus, MPEP 2163 states in pertinent part: "If

a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met ..." and that "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient." Applying MPEP 2163 for specific support in the specification (for the written description and enablement requirements), Applicant incorporates by reference the previously-provided explanation, and specific example citations to pages and lines numbers, for the requisite support and enablement aspects with respect to the above three terms. See also MPEP § 2163.02 ("(t)he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.") Based on such incorporated discussion and the related discussion herein, Applicant submits that the specification clearly satisfies the appropriate standard under §112(1).

With regards to the claim term "bank account", Applicant also notes that the Office Action has acknowledged that the specification provides correspondence between "bank account" and a checking or savings account, and submits that the rejection of claims 53 and 64 (which explicitly specify checking, savings or interest-bearing account) appears to be inadvertent or at least not explained with this rejection.

The §112(1) rejections relative to the claim terms, "providing a time window for users to provide funds for the transaction card purchases" and "a communication protocol implemented with the user during the transaction", have the same issues in that the rejection is unsupported and is based on the same incorrect standard. Moreover, the Office Action acknowledges that the specification provides an example in the form of a "payment period countdown" such as a fifteen-day period "wherein said payment period is a period of fifteen days."

With respect to "a communication protocol implemented with the user ...", again under MPEP 2163, the issue is: "[W]hether applicant has demonstrated possession of the claimed invention. Such a review is conducted from the standpoint of one of skill in the art at the time the application was filed (see, e.g., *Wang Labs. v. Toshiba Corp.*, 993 F.2d 858, 865, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993)) and should include a determination of the field of the invention and the level of skill and knowledge in the art." MPEP 2163 explains that "what is conventional or well known to one of ordinary skill in the art need not be disclosed in detail," and that the "written description' requirement must be applied in the context of the particular invention and

the state of the knowledge.... As each field evolves, the balance also evolves between what is known and what is added by each inventive contribution.... If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met.” In this instance, Applicant presented numerous examples in support of “communication protocol ...” as claimed, and these include citations in the specification to FIG. 3, related user-system interactions as discussed at page 6, line 28 et seq. and therein for particular examples, to such user-system interactions over a secure Internet interface.

Accordingly, Applicant submits that §112(1) rejection should be withdrawn because the specification satisfies §112(1) with respect to each of these terms, and because the rejection is unsupported and is based on an incorrect (*ipsis verbis*) standard.

Regarding the § 112(2) rejections based upon the claim limitation “consideration-bearing banking account,” To the extent that this rejection might implicitly question consistent use and/or support in the specification for this term, Applicant again incorporates by reference Applicant’s arguments presented in Applicant’s Previous Response (bottom of page 11 to top of page 12) and submits that the claim term “consideration-bearing bank account” has no special meaning and therefore carries no requirement for a definition in the claim terms. The rejection, however, appears to be based on a failure of the specification to provide a definition of this term. Accordingly, Applicant submits that no definition of this term is needed its uses in the specification are consistent with the ordinary meaning of “bank account” (e.g., funds deposited by a customer for entrusting to a bank and subject to withdrawals by the customer (as exemplified in the specification by way of a savings account or a checking account). See also MPEP § 2163.02 (as cited above). In support thereof, reference may be made to American Heritage Dictionary, Copyright 2000 at dictionary.com (“bank account: n. funds deposited in a bank that are credited to and subject to withdrawal by the depositor”). This term is well-understood term and commonly used by those skilled in the art to refer to and has been used in a multitude of U.S. Letters Patent¹. Similarly, as for the adjective in this claim term, “consideration-bearing”, Applicant submits that no definition is needed because its ordinary meaning applies and because explicit examples are provided in the specification and in claims 53 and 64 (which are rejected even though they expressly comply with whatever standard is asserted in the Office Action for § 112(2)). As the record is clear on this issue and the rejection

presents no evidence or rationale in support thereof, Applicant submits that the § 112(2) rejections should be withdrawn.

Turning now to the rejections under § 103, these rejections fails to establish correspondence to the asserted references. First, these rejections rely upon the above-noted § 112 assertions in an attempt to ascribe a special meaning to the claim term “bank account” in a manner that contradicts the evidence of record, including definitions accepted throughout the banking industry, and the uses in the specification, and in the patents noted above. In support thereof, Applicant incorporates the above discussion and evidence referring to use and ordinary meaning of “bank account”. The rejection relies on the flawed argument that since the ‘279 reference has a “reconciliation of credit card transactions with bank records”, then somehow there is a consideration-bearing bank account as used claimed by Applicant. In the ‘279 reference, however, this discussion does not suggest or require that the transaction be associated with anything other than a credit account – not a bank account. Indeed, in such references, amounts owed for credit card transactions are paid by way of payment by checks associated with unrelated checking-type bank accounts. Applicant submits that this argument is illogical, unsupported by the record and employs a definition that is inconsistent with the ordinary use of the term “bank account”. Further, in considering the claimed invention “as a whole” (35 U.S.C. §103), the citations to these references for the claim clauses including the term “bank account” are entirely unrelated; in claim 1, e.g., these claim clauses include all including and following the clause “monitoring” When considering the explicit limitations of claims 53 and 64, Applicant respectfully submits that the rejections may have been inadvertently applied.

Applicant respectfully submits that there are several other aspects set forth in the claimed invention and for which the Office Action has failed to cite evidence, or even expressly assert, correspondence to the prior art. Examples include the claim limitations directed to withdrawing funds from the bank account. In connection with the combined teachings, the Office Action has failed to expressly identify or delineate the credit account relative to the alleged bank account, or to explain where the references implement the operations relating to withdrawals. In claims 48 and 59, for instance, the claimed invention requires both “tracking purchases ...” and “tracking withdrawals” but the Office Action makes no attempt to explain how these operation would be carried out in the asserted prior art. Insofar as neither asserted reference includes such limitations, no combination of

¹ See, e.g., 6,947,897; 6,938,821; 6,910,020; 6,871,287.

their teachings can be arranged in a manner that would correspond under the rigorous requirements of § 103.

Moreover, the §103 rejections attempt to show that the skilled artisan would be motivated to combine teachings without any evidence for the combination and in an illogical manner that would result in a system that is entirely different than the one intended by the primary reference. Applicant first points out that, contrary to the requirements of the law under §103, no evidence is presented to support the Office Action argument that a skilled artisan would be led by the prior art to modify the ‘279 reference in any manner related to the assertions in the Office Action. The Office Action does not cite anything in this regard for the record.

Applicant also refers to MPEP § 2143.01 and the rule that a §103 rejection cannot be maintained when the asserted modification undermines purpose or operation of the reference being used for the rejection. Applicant submits that, to the extent that the Office Action provides a discernible explanation of the combination of teachings, the system resulting from the assertion would be entirely different than the one intended by the primary reference; therefore, the primary reference would teach away from the asserted combination of references. The Office Action asserts the ‘279 patent as the primary reference and, because this reference does not have many of Applicant’s claimed aspects (e.g., the acknowledged aspects relating to a timing window), the ‘552 reference is relied upon to overcome noted deficiencies in the ‘279 patent. More specifically, the Office Action appears to be alleging many of the operations taught by the ‘552 patent for its multi-purpose account would be used somehow in combination with one of the embodiments of the ‘279 patent. While the Office Action may have intended to explain how aspects of the embodiment of the ‘279 patent would somehow be displaced and/or supplemented by these teachings of the ‘552 reference, any such combination would undermine the objectives stated in the ‘279 patent. These objectives include integrated financial management of multiple credit card accounts relative to internal company controls (Col 1:41-61), and reconciliation between recorded financial transactions and the credit card activity (Col 1:62-64, Col. 2:1-14). By merging the two sets of teachings as asserted for the §103 rejections, the resultant system would be operating on a single multi-purpose account and, therefore, would not be operating so as to provide these reconciliation-based objectives. Moreover, the resultant system would no longer correspond in the manner alleged in the Office Action as set forth for the §103 rejections. Applicant submits that this rejection is untenable.

Applicant hereby incorporates by reference the arguments presented in the previous Response and reserves the right to represent such arguments.

In view of the above discussion, Applicant believes that each of the rejections is overcome, and that the application is in condition for allowance. A favorable response is requested.

Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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